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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,872	09/11/2000	Ian H. Duncan	98784-US	1351

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EXAMINER

BARANYAI, LAWRENCE

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,872

Applicant(s)

DUNCAN ET AL.

Examiner

Lawrence Baranyai

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

- a. The method of forwarding packets, as recited in claim 1, is not provided in the figures and such a method is commonly described using a method/step chart.
- b. The details of the packet forwarder, as recited in claim 8, are also not provided.

The method of packet forwarding and packet forwarder must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

1. The specification is objected to as failing to comply with 37 CFR 1.74 because it fails to include reference numbers for the essential elements of the claimed invention as described in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings and specification will not be held in abeyance.
2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Art Unit: 2665

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Claims recite subject matter regarding a method forwarding packets and a packet forwarder.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter of claims 1, 7, and 8. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

a. A packet forwarding method is not described in the specification as recited in claim 1. The disclosure fails to provide an antecedent basis to support the essential elements of the claim including: providing said system with multiple forwarding tables; selecting an appropriate forwarding table based on a source address in said packets; and forwarding said packets to one of said ports based on a destination address in said packets and information in said appropriate forwarding table.

b. A packet forwarder apparatus/device is not disclosed in the specification as recited in claim 8. There is no basis provided in the specification for the essential elements of the claim including: said service interfaces including source and destination addresses; multiple forwarding tables defining isolated realms to which said service interfaces belong based on said source information; and forwarding means to direct said service interfaces to an appropriate port based on the destination address and information in said forwarding table.

c. There is no antecedent basis in the specification for the ATM backplane recited in claim 7.

Claim Objections

1. Claims 7, 14-22 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

a. Dependent claim 7 recites the additional limitation of "a method as defined in claim 1 wherein said internetworking devices include an ATM backplane". The parent claim does not specify "said internetworking devices".

b. Dependent claims 14-22 recite the additional limitation of "A system as defined in claim 13". The parent claim does not specify "a system".

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is not enabling with respect to the claimed method of packet forwarding or the packet forwarder as detailed in claims 1 and 8, respectively. Amended independent claims 1 and 8 introduce subject matter that is beyond the scope of the application as originally filed. Claim 1 includes the use of multiple forwarding tables and

Art Unit: 2665

forwarding based upon "information" in the said "appropriate" forwarding table. These aspects are not described in the specification to enable one of ordinary skill in the art to make/use the claimed invention. Claim 8 for a packet forwarder includes "multiple forwarding tables defining isolated realms" and forwarding means directed to an "appropriate" port based on "information" in the said forwarding table. These aspects are also not described in the specification to enable one of ordinary skill in the art to make/use the claimed invention. (Note: See also International Preliminary Search report for the associated PCT/CA 98/00937 application provided by applicant.)

2. Dependent claims 2-7 and 9-22 are rejected since they are dependent claims based on the above rejected independent claims.

Citation of Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Arora (EP 0797331A2) discloses a similar method for a highly flexible internetworking services system. Bronstein (WO 96/04729) discloses for system for interworking legacy or ATM workstations over an ATM network.

Examiner Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Baranyai whose telephone number is (703) 305-8707. The examiner can normally be reached on Monday-Thursday: 6:30am-5:00pm.

Art Unit: 2665

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

Lawrence Baranyai
Examiner
Art Unit 2665

lb



HUY D. VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600